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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,895	07/15/2002	Jill Ann Williams	DLT 00002	1554

7590 09/21/2004

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EXAMINER	
MANAHAN, TODD E	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,895	WILLIAMS ET AL.	
	Examiner	Art Unit	
	Todd E. Manahan	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21,23 and 24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21,23 and 24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *06/18/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The references cited in the IDS filed 18 June 2004 are duplicate citations of those references cited in the IDS filed 11 February 2002 and previously considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-21,23 and 24 rejected under 35 U.S.C. 101 because the claimed invention is inoperative and therefore lacks utility. The claims recite a method of manufacturing a product, however the steps therein only recite providing different elements, nothing is produced or manufactured in the claimed process and thus the process a claimed is inoperative and lacks utility.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 7/1-7/3, 8, 9-11, 12, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (United Sates Patent No. 5,149,268) in view of Wilson et al. (United Sates Patent No. 5,611,793).

Johnson discloses the method of treating a dental root canal essentially as claimed except for the steps of introducing a flowable photosensitiser into the root canal and activating it with a light via an optical fiber. Wilson et al disclose a method of disinfecting tissues of the oral cavity comprising applying a photosensitiser to the surgically induced wound and thereafter exposing it to laser light via an optical fiber. It would have been obvious to one skilled in the art to provide the method of treating a dental root canal of Johnson with the steps of introducing a flowable photosensitiser into the root canal and activating it with a light via an optical fiber in view of Wilson et al in order to disinfect and sterilize the root canal prior to filling. Regarding the apparatus or kit claims, to provide all the equipment needed to perform the method of the combination of Johnson as modified by Wilson et al. would have been obvious to one skilled in the art in order to facilitate performing such method. Regarding claim 8, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408 (1961).

Claims 1, 4-6, 7/1, 7/4-7/6, 8-10, 12/9, 12/10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vari (European Patent No. EP 0830852 A1, cited by applicant)) in view of Wilson et al. (United Sates Patent No. 5,611,793).

Vari discloses the method of treating a dental root canal essentially as claimed except for the steps of introducing a flowable photosensitiser into the root canal and activating it with a light via an optical fiber. Wilson et al disclose a method of disinfecting tissues of the oral cavity comprising applying a photosensitiser to the surgically induced wound and thereafter exposing it

to laser light via an optical fiber. It would have been obvious to one skilled in the art to provide the method of treating a dental root canal of Vari with the steps of introducing a flowable photosensitiser into the root canal and activating it with a light via an optical fiber in view of Wilson et al in order to disinfect and sterilize the root canal prior to filling. Regarding the apparatus or kit claims, to provide all the equipment needed to perform the method of the combination of Vari as modified by Wilson et al. would have been obvious to one skilled in the art in order to facilitate performing such method. Regarding claim 8, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408 (1961).

Response to Arguments

Applicant's arguments filed 18 June 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that the combination of Wilson with either Johnson or Vari is not obvious because otherwise Wilson would have suggested it (i.e. that the Wilson reference is applicable to endodontic work) either at the time of filing or since then, the mere fact that no one has gotten a patent on a specific combination does not necessarily mean that it is not obvious, it merely means that no one has gotten a patent on this combination. The reason might be, simply, because the combination is obvious. Furthermore, Wilson does suggests use not only for periodontal disease, but also disinfecting cavities and "other forms of dental surgery" (col. 1, lines 19-21, and col. 2, lines 12 and 13).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 703 308-2695. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
17 September 2004